



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,758	01/18/2002	Thomas R. Cech	015389-002980US	6144

34151 7590 05/26/2006

TOWNSEND AND TOWNSEND AND CREW LLP
8TH FLOOR
TWO EMBARCADERO CENTER
SAN FRANCISCO, CA 94111

EXAMINER

UNGAR, SUSAN NMN

ART UNIT PAPER NUMBER

1642

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,758

Applicant(s)

CECH ET AL.

Examiner

Susan Ungar

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 1/9/06, 1/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 9-16, 24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-8, 25 and 27-28 is/are allowed.
- 6) ☐ Claim(s) 23 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CAR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on January 9, 2006 and January 27, 2006 are acknowledged and have been entered. Claims 21-22 have been canceled and new claims 27-29 have been added. An action on the RCE follows.

2. In the amendment filed January 9, 2006 Applicant asserts that SEQ ID NO:67 is entitled to priority at least to April 18, 1997 and April 25, 1997 since SEQ ID NO:67 corresponds to the SEQ ID NO:67 of both USSN 08/844,419 and USSN 08/846,017 filed on the cited dates and requests Examiner to consult the files rather than providing Examiner with page and line number supporting the instant claims drawn to SEQ ID NO:67. In response to Applicant's request Examiner has indeed consulted the files and found that the instant SEQ ID NO:67 is found in both USSN 08/844,419 and USSN 08/846,017, however, nothing in either application supports claims drawn to an antibody that binds to SEQ ID NO:225 but not to SEQ ID NO:67 or to a monoclonal antibody obtainable by immunizing a non-human with SEQ ID NO:67 or a monoclonal antibody that binds to SEQ ID NO:67 but not to SEQ ID NO:68. The previously assigned priority date therefore stands. Applicant is invited to submit evidence pointing to the serial number, page and line where support can be found establishing an earlier priority date for the instantly claimed invention.

2 Claims 1-8, 23, 25 and 27-29 are pending and currently under examination.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. It is noted that a review of
5. The following rejections are being maintained:

Claim Rejections - 35 USC 112

6. Claim 23 remains rejected under 35 USC 112, first paragraph and claim 29 is rejected under 35 USC 112, first paragraph for the reasons previously set forth in the action mailed August 10, 2005, Section 6, pages 3-4.

Applicant, in the paper submitted January 9, 2006, reiterates arguments drawn to *In re Johnson*. The arguments were previously considered but not found to be persuasive for the reasons of record.

Applicant, in the paper submitted January 27, reiterates and amplifies arguments drawn *In re Johnson*. The arguments were previously considered but are not found to be persuasive because for the reasons of record, *In re Johnson* is not relevant to the instant claims.

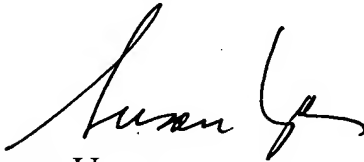
7. Claims 1-8, 25, 27-28 appear to be free of the art and allowable.
8. All other objections and rejections recited in the previous Office Action are hereby withdrawn.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at 571-272-0787. The fax phone number for this Art Unit is (571) 273-8300.

Application/Control Number: 10/053,758
Art Unit: 1642

Page 4

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

A handwritten signature in black ink, appearing to read "Susan Ungar", with a stylized flourish at the end.

Susan Ungar
Primary Patent Examiner
May 18, 2006